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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/615,351	07/12/2000	Wlodek W. Zadrozny	728-168 (YOR9-2000-0204)	3274
7590 01/20/2004			EXAMINER	
Paul J Farrell Dilworth & Barrese 333 Earle Ovington Blvd Uniondale, NY 11553			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/615,351

Applicant(s)

ZADROZNY ET AL.

Examiner

Jan Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2000 and 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23, 46-56, 82 and 83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23, 46-56, 82 and 83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on July 12, 2000 and October 17, 2003, wherein:

Claims 1-23, 46-56, and 82-83 are currently pending in this application.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on July 12, 2000 is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-2, 10-13 and 46-51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to

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pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1-2, 10-13, and 46-56 only recites an abstract idea. The recited steps of merely creating a list, receiving information, receiving qualifications and organizing, matching or sorting do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to search a database based on specified criteria or qualifications.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention searches a database (i.e., repeatable) based on specified criteria or qualifications (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, searching a database based on specified qualifications, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1-2, 10-13 and 46-56 are deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-23, 46-56, and 82-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1, 14, 46, 52, and 82, the applicant identifies the invention in the preamble as being a method or system for “developing an inventive idea.” However, the claim language does not develop an inventive idea. The claim language identifies a method or system for creating a list, receiving information, creating qualifications or criteria and performing a search to match, organize, or sort the list. The invention does not accomplish what the applicant states that it is supposed to do. Claims 2-13 read on claim 1, Claims 15-23 read on claim 14, claims 47-51 read on claim 46, claim 53-56 read on claim 52, and claim 83 reads on claim 82.

5. Claims 1-23, 46-56, and 82-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the claims recite two concepts or inventions. The preamble identifies a method or system for developing an inventive idea while the claim language is to a system or method for searching a database based on qualifications or criteria.

6. Claim 1 recites the limitation “said patent proposal,” in line step 2 of claim 1. There is insufficient antecedent basis for this limitation in the claim.

7. Claims 1-13, and 46-56 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps and elements, such omission amounting to a gap between the steps and elements. See MPEP § 2172.01. The omitted steps or elements are:

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How is the inventive idea developed? What creates the subscriber list, what creates the proposal, and what creates the qualifications? How are the subscribers contacted? How is the forum provided and how is the communication performed? How is the forum secured? How is the access provided to the secure forum? How is the non-subscriber criteria established? How is the confidentiality level established? How is a fee obtained? How is the message sent from the server? How does one receive the message?

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8. Claim 52 is “a for a method of doing business by providing an inventive idea development service to a corporation comprising the steps of” and the applicant had only provided one step of providing a secured forum.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-13, 46-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Atcheson et al. (US Patent 5,583,763) (hereinafter referred to Atcheson).

Atcheson discloses a method comprising creating a list (database includes a plurality of datafiles containing a plurality of preferences, Fig. 4.(300), (302)), receiving information, creating criteria or qualifications (target user inputs signal to indicate a set of preferences), and searching or matching based on the criteria (database is searched to determine the number of user preferences that match preferences in the datafiles) (Fig. 3, 4 col. 2, lines 16-27)

Atcheson does not disclose developing an inventive idea, a subscriber list, receiving a proposal, or creating a pool of co-inventors. The fact that the method for searching a database based on the qualifications is for developing an inventive idea is non-functional descriptive material and is given little patentable weight. The fact that the list is a subscriber list, that the information is a proposal, and that the qualifications are for co-inventors or that the match list is identified as a co-inventor pool is also non-functional descriptive material and carries little patentable weight. They add little, if anything, to the claimed steps and thus do not serve as a limitation on the claims to distinguish over the prior art.

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The dependent claims are rejected for incorporating the defects from the parent claim by their dependency.

10. Claims 14-23 and 82-83 are rejected under 35 U.S.C. 102(b) as being anticipated by Atcheson.

Atcheson discloses a network (100) used to transfer information, a server (inherent in a network system), a terminal for transmitting information (108), a database for storing list and records (Fig. 2, fig. 3 (210), fig. 4(300, 301).

The fact that the system is used by inventors, co-inventors, for developing an inventive idea or that the information is a patent proposal is all non-functional descriptive material and is given little patentable weight.

The dependent claims are rejected for incorporating the defects from the parent claim by their dependency.



### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Linz (US 2001/0032112) discloses a method, system and program for selecting job candidate which match with predetermined criteria.

Agnew, Marion, Collaboration on the desktop, Information Week. Manhasset, July 10, 2000 describes how collaboration-software is now being used by companies to discuss product rollout where none of the participants are in the same place.

[www.eroom.com](http://www.eroom.com) describes collaborative development used to support and integrate project teams that span multiple organizations.

Bungo.com describes an Internet technology company that offers the work's leading information management and collaboration environment.

Harshaw discloses a method for new product development and market introduction comprising the steps of providing a pools.

Narang discloses a method and system for facilitating the collaborative creation of works over a computer describing the collaborative site.

Waters discloses a system and method for obtaining ideas from independent sources.

Harrell et al discloses a system and method for dynamically matching knowledge capital with developers capable of developing knowledge.

Foster et al discloses a computer implemented collaboration system.

Lalonde et al discloses a data processor including means for receiving profile data and comparing the data to ads.

Xerox Corporation (EP 1050831) discloses a system for providing a document change information system for a community of users.

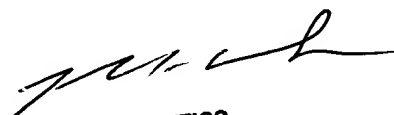
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-308-3691.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

JM

  
JOHN G. WEISS  
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